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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,956	03/30/2004	Minoru Sakai	FS-F03329-01	4088
37398	7590	12/27/2004	EXAMINER	
TAIYO CORPORATION 2111 JEFFERSON DAVIS HIGHWAY #412, NORTH ARLINGTON, VA 22202			SCHILLING, RICHARD L	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/811,956

Applicant(s)

Sakai et al

Examiner

RL Schilling

Group Art Unit

1752

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 11-30-04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-22 is/are pending in the application.
- Of the above claim(s) 17-22 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-16 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) HP 3-304
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. The requirement for restriction is repeated and made FINAL. The election without traverse is noted.

2. Claims 1-16 are rejected under the first paragraph of 35 U.S.C. § 112 as being based on insufficient disclosure. The specification fails to show one skilled in the art how to carry out the processes of the instant claims using the materials of the instant claims without imagewise exposure to light. Imagewise exposure to light is necessary for thermal development to take place where the photosensitive silver halide is exposed to light to form an image. Also, in regard to claims 1-9, thermal development after imagewise exposure to light is necessary to form an image.

3. Claims 1-9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claim 1 requires a line speed of thermal development but not a thermal development step. How the image forming apparatus of claim 1 is used is indefinite.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(e) The invention was described in (1) an application for patent, published under

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Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nishijima et al. '649. Nishijima et al. (see particularly column 2, lines 23-68; compounds 28-75; column 74, line 51 - column 75, line 15) discloses photothermographic elements comprising the bisphenol reducing agents as set forth in the instant claims when R<sub>o</sub> in Formula S of Nishijima et al. is

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alkyl. Nishijima et al. discloses that heating or thermal development depends on temperature and discloses heating at higher temperature for shorter periods of time, e.g. 1 second-2 minutes. If Nishijima et al. do not disclose the fast development times of the instant claims, then it would at least be obvious to one skilled in the art to use high temperature development for shorter development times in the processes of Nishijima et al. including thermal development times providing line speeds of 20 nm per second or higher.

5. Oya et al. and Katoh are cited of interest in the art as disclosing photothermographic elements within the scope of the structural formula set forth in the instant claims. V<sub>9</sub> in Oya et al. may be cycloalkyl, alkenyl, aryl or heterocyclic groups. The prior art submitted by applicants has been considered.

6. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

December 21, 2004

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 1400/1752

